

REMARKS

The Reply Brief mailed 22 December 2004 has been received and reviewed. In view of the fact that the Reply Brief contains a new ground of rejection, applicant hereby requests, pursuant to the provisions of 37 CFR Section 41.39(b)(1), that prosecution be reopened in this application. Consistent with this request, the applicant submits the above Amendment under the provisions of 37 CFR 1.111.

Claims 1 through 17 are currently pending in the application. By this Amendment Applicant has amended claims 1, 3, 5-8, 11 and 17 in an effort to place the aforesaid claims in condition for allowance. Claims 4 and 16 have been cancelled.

REJECTIONS UNDER 35 USC 103:

Claims 1-5 and 11-17 stand rejected under 35 USC 103. In her Reply Brief the Examiner indicated that claims 4, 5, 16 and 17 were allowable dependent claims. Responsive to the indications of the Examiner, applicant has amended Claim 1 to include all of the limitations of Claim 4. It follows that Claim 1 (amended) is in essence, the former Claim 4, rewritten in independent form to include all of the limitations of its base claim. In view of the indications of the Examiner, Claim 1 (amended) should now be allowable. Further Claim 5, which depends from Claim 1 (amended) should also be allowable.

Claim 11 has been amended to include all of the limitations of Claim 16. It follows that Claim 11 (amended) is in fact Claim 16 rewritten in independent form to include all of the limitations of its base claim, i.e. Claim 11. Claim 11 (amended) should now be in allowable condition. Claim 17 depends from Claim 11 and should also now be in allowable condition.

Given the allowability of Claims 1 and 11, the claims depending either directly or indirectly from these claims, i.e. claims 2-3 and 12-15 should also be allowable in view of the same reasons which support the allowability of claims 1 and 11 respectively and further in view of the further structural limitations set forth in these dependent claims.

Claims 6-10 stand rejected under 35 USC 103 over Shephard in view of Auer and De Zen. Claims 7-10 stand rejected further in view of Veenema.

(A) Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03, *i.e.*, in order “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success in combining the references. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the expectation of success must both be found in the prior art, and not based on Applicants' disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, in establishing a *prima facie* case of obviousness the initial burden is placed on the examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See also MPEP § 706.02(j) and § 2142.

The Supreme Court has established the standard of patentability to be applied in obviousness rejections in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). This standard has been summarized in MPEP § 2141 into four factual inquiries including “(A) determining of the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations.” It should be noted that, when applying the required patentability standards of *Graham*, the basic considerations which apply to obviousness rejections based on 35 U.S.C. § 103 should include the following principles of patent law: “(A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible

hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined.” *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

(B) Obviousness rejections of claim 6 over Shepherd in view of Auer and De Zen.

Applicant respectfully traverses the rejection and submits that Shepherd in view of Auer and De Zen, individually or in any combination thereof, does not support a *prima facie* case of obviousness of the present invention recited in the presently amended claim 6 because (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art of the instant invention to modify the reference or to combine the reference teachings; and (ii) the prior art references do not teach or suggest all the limitations recited therein (*Vaeck*, supra).

Claim 6 is directed to a plurality of adjacently positioned modules which are fixedly joined to one another at their respective ends to form a passageway of an airport boarding bridge. The modules are joined to one another by connection structure which operates to mechanically secure the ceiling elements of adjacent modules to one another. The connection structure also operates to mechanically secure the floor elements of adjacent modules to one another. Applicant respectfully submits that the art relied upon by the Examiner neither teaches nor suggests the claimed construction.

The Shepherd reference teaches a boarding bridge construction which is telescopic in nature. (See Col. 1, lines 20-24.) In view of this telescopic nature, it follows that Shepherd is not directed to a boarding bridge structure wherein adjacent modules of that bridge are fixedly secured to one another. Any attempt to modify Shepherd by replacing the telescopic association of adjacently positioned modules (A), (B), and (C) of Shepherd would result in a complete departure from the operation of the Shepherd construction. Shepherd’s invention is directed to providing a plurality flexible carrier tubes which can respond to changes in the configuration of the boarding bridge caused by the extending and retraction motion of the telescoping modules. To modify the Shepherd bridge by securing adjacent modules fixedly to one another would impermissibly modify the nature of the operation of the Shepherd bridge. It follows that any

attempt to suggest that the Shepherd bridge be modified in view of Auer and De Zen to produce a bridge wherein adjacent modules are fixedly secured to one another is impermissible under the provisions of 35 USC 103.

Applicant respectfully submits that the lack of suggestion and motivation to combine Shepherd with Auer and De Zen is based on the fact that the proposed modification of the combination of Shepherd with Auer and De Zen to find obviousness in the present invention at most renders the prior art of Shepherd unsatisfactory for its intended purpose or, at least, changes its principle of operation. It is well known that “if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Not only would a combination of Auer with Shepherd impermissibly alter the operation of the Shepherd reference but furthermore, applicant respectfully submits that there is no indication of a motivation to combine Auer with Shepherd. Auer relates generally to structural systems, and specifically relates to extruded structural systems which include extruded structural panels and extruded panel joining members for assembling a structural system with a plurality of panels (Auer, col. 1, lines 9-13). Auer teaches explicitly that “structural assemblies made with the preferred embodiment of the present invention may be successfully employed in such diverse applications as electrical utility cooling tower louvers, floating covers for oil and other petroleum product storage tanks, anti-corrosive structures for use in harsh chemical plant environments, computer room flooring, self-supporting conduit for electrical and utility cabling, energy efficient insulated building siding for storage shelters and refrigerated enclosures, air intake housings and ducting, architectural room dividers, and heavy equipment hoods and enclosures” (Id., col. 1, line 65 – col. 2, line 8). Applicant respectfully submits that Auer does not teach or suggest the use of his invention in a passageway within a boarding bridge for facilitating passage between an aircraft terminal and a docked aircraft. Furthermore, there is no suggestion in Auer

to modify Shepherd to include pultruded panels in a boarding bridge passageway.

The instant Claim 6 requires that the connection structure fixedly secure the ceiling elements and the floor elements of adjacently positioned modules. Shepherd teaches an extendable-retractable interconnection of adjacent modules. It follows that Shepherd does not teach a fixed connection of adjacently positioned modules. Neither Auer nor De Zen appear to teach that ceiling elements and floor elements of adjacently positioned modules be mechanically secured to one another to form a fixed connection of the two adjacently positioned modules. It follows that any combination of the three references would likewise neither teach or suggest a construction wherein adjacently positioned modules would be fixedly secured to one another by means of a mechanical connection between ceiling elements and floor elements. In view of this consideration, applicant respectfully submits that Claim 6 distinguishes over the references relied upon by the Examiner.

Claims 7-10 stand rejected over Shepherd in view of Auer, De Zen and further in view of Veenema. Applicant has amended Claim 7 to more fully clarify the structure of the connection structure which secures adjacent modules to one another. Specifically applicant claims a structure which includes two horizontally extending first frame structures which are each individually secured to a respective ceiling element. Each first frame structure defines an upstanding ear. The claim further requires two second frame structures which are each individually secured to a respective floor element and have a downwardly extending ear. The first frame structures are positioned in abutment one against another, as are the second frame structures. The first frame structures are secured to one another by connection structure, as are the second frame structures.

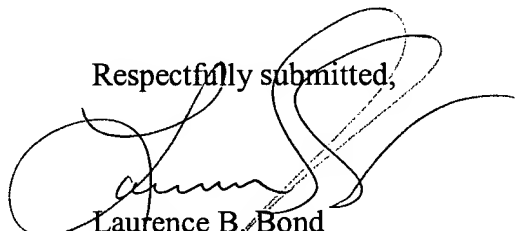
The Examiner maintains that the Veenema references teaches the claimed connection structure. Applicant respectfully disagrees and respectfully submits that Veenema neither teaches nor suggests the claimed structure. Firstly, Veenema's alleged first frame structures, rails 30a and 34a, are not in abutment, instead they are maintained spacedly apart from one another by the panel 14. Secondly, Veenema is not directed to fixedly securing two adjacently positioned modules to one another at their respective ends. Instead, Veenema is directed to a structure for retaining the walls of a container in place. The instant claims require each of the

first and second frame structures to define outwardly extending ears. The claim further requires first and second connection structure which is secured respectively to the ceiling and floor elements. This first and second connection structure interacts with the ears of each of the frame structures to form a fixed securement of the two modules one to another. Veenma does not appear to teach nor suggest connection structure which is secured respectively to a ceiling and a floor element which interacts with the ears of a frame structure to form a mechanical securement of two adjacently positioned modules. In view of these considerations, applicant respectfully submits that Claim 7 distinguishes over the references relied upon by the Examiner. Since claims 8-10 also depend from Claim 7, applicant submits that these claims are likewise allowable in view of the reasoning which supports the allowability of Claim 7 and further in view of the further structural limitations set forth in those claims.

CONCLUSION

In view of the present amendments and the arguments advanced, Applicant respectfully requests reconsideration of its application.

Respectfully submitted,



Laurence B. Bond
Registration No. 30,549
Attorney for Applicant
TraskBritt, PC
P. O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: (801) 532-1922

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